

REMARKS

Applicant now has had the opportunity to carefully consider the Examiner's comments set forth in the Office Action mailed June 27, 2006. Reconsideration and re-examination is respectfully requested.

Claims 1, 6 and 11 have been amended. Claims 1, 3-6, 8-11 and 13-15 remain in the application. Claims 2, 7 and 12 have been canceled.

The Office Action

Examiner rejected claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Qua (U.S. Patent No. 6,222,909) in view of Bartfeld (U.S. Publication No. 2003 0086432).

The Subject Invention

By way of review, the subject invention relates to a method and apparatus for providing a network based voice memo feature. In at least one form, the invention is directed to a system that will provide network based functionality to allow a user to record a voice memo during an ongoing call. The invention allows a subscriber to create a voice message, based on the recorded memo, and store the message in the user's voice messaging system for later retrieval. In applying this method, the invention comprises opening a connection between the mobile station and the voice messaging system based on a first code. The claimed method continues with recording a voice data transmitted on the reverse link subsequent to the detection of the first code in the voice messaging system through the open connection. The claimed invention also includes terminating the connection between the mobile station and the voice messaging system based on the second code.

The Cited Art

Qua (U.S. Patent No. 6,222,909) is an audio note taking system and method. The system enables a user to take multiple audio notes of a specific conversation by starting and stopping a recording device and by generating appropriate control signals from a respective communication device during that conversation. The invention stores the user's memo in a storage unit which will enable the user to forward the message to other storage devices such as email. The storage unit may be detachable and can be

connected using socket interface cable or other similar technique. Furthermore, the invention may include a storage unit that is connected to the network itself. In any form, the user of the Qua reference may distribute the stored information to oneself or other parties once the information has been recorded.

Examiner also cited Bartfeld (U.S. Publication No. 2003 0086432). Bartfeld is a telephone call management system. Bartfeld allows for a call review where a voice message is being recorded for a specific telephone. Bartfeld allows for the message to be played on a telephone associated therewith during the time it is recorded. Optionally, the call may further be retrieved and rerouted to a user telephone responsive to the command entered via the telephone/television distribution gateway. In any sense, Bartfeld allows the call to be recorded responsive to commands entered via the gateway.

The pending claims are not obvious over Qua in view of Bartfeld.

Examiner rejected claims 1-15 under U.S.C. §103(a) as being unpatentable over Qua in view of Bartfeld. Examiner will appreciate that all independent claims (claims 1, 6, and 11) have been amended in order to further clarify the invention. Furthermore, Examiner will appreciate the claims 2, 7 and 12 have been cancelled. Applicants respectfully requests that the rejections to the remaining claims be withdrawn for at least the following reasons.

There is no motivation to combine Qua and Bartfeld.

Qua expressly teaches away from the teachings of Bartfeld, stating that such communication techniques are ineffective in order to gain full advantage of the portable wireless devices. Qua is designed to be used in non-traditional environments outside the home or office (see column 1, lines 14-22). Applicant acknowledges Examiner's response to the arguments detailed in the office action. However, while it is true that when the prior art shows a mere disclosure of more than one alternative, it does not constitute teaching away from these alternatives. However, the proper inquiry for a proposed combination is "whether there is something in the prior art as a whole that suggests *desirability* and thus the obviousness of making the combination *In re Fulton*,

391 F.3d 1195, 73 USPQ 2d 1141 (Fed. Cir. 2004). It is hereby submitted that Qua does not suggest the desirability as noted above and, therefore, the obviousness of Bartfeld.

In the alternative, Qua offers criticism of the solution claimed in Bartfeld by stating that one cannot take full advantage of the portable/wireless aspects of the device while it is being used in non-traditional environments. Furthermore, Qua goes on to state that “devices described in prior art references have included the ability to make recordings at the device itself of ongoing conversations. However, these prior art references make no mention however of a manner in which a user can distribute the stored information to oneself or to other parties once the information has been recorded”. See column 1, lines 35-41. In this section, Qua is clearly directly criticizing solutions that do not allow a user to distribute the information that has been recorded. This is the paramount reason why Qua references a storage device as opposed to a voice mail server. For example, as stated in the summary of the invention section, column 1, lines 40-45, “The present invention is a system and method that permits a user to record audio information....and distribute the information to other parties in a number of different formats”. Continuing on, Qua states, “Importantly, the present invention provides an interface with other communication systems...in order to distribute the stored audio information in an accurate and comprehensive matter”. In this sense, Qua clearly offers direct criticism of the solution claimed in the Bartfeld reference because Qua’s principle purpose is to store the audio note in a manner so it can be processed and distributed in different formats. Opening and then closing a connection between a mobile station and a voice messaging system would make it more difficult, if not impossible, to manipulate the messages as suggested in Qua.

In this regard, the claimed combination of Qua and Bartfeld would change the principle operation of the primary reference (Qua) and render the reference inoperable for its intended purpose. Therefore, Qua and Bartfeld are not combinable. MPEP §2141.02. Again, Qua states at column 1, line 45, “importantly, the present invention provides an interface with other communication systems. For example, voice servers, email servers and personal computers in order to distribute the stored audio information in an accurate and comprehensive manner”. Qua clearly states that one of its intended

purposes is to provide a principle operation of distribution of the stored audio information. The combination of Bartfeld and Qua would not operate in order to fulfill Qua's intended purpose. If the stored audio was indeed processed through opening a connection between the mobile station and a voice messaging system, as Examiner suggests, no interface would be provided in which to distribute the stored audio information. The stored audio information in turn would be in the subscriber's voice messaging system. Therefore, under MPEP §§2143.01 and 2145, Qua and Bartfeld are not combinable. It is hereby requested that the rejection to claims 1-15 be withdrawn.

The combination of Bartfeld and Qua does not disclose all the elements of the claimed invention.

Examiner will appreciate that independent claims 1, 6 and 11 have been amended to include the language of validating whether the mobile station is enrolled in a voice memo feature program by accessing a subscriber database. Even assuming the propriety of the combination between Qua and Bartfeld, neither reference, nor the combination of the two references, disclose validating the mobile station by accessing a subscriber database. It is, therefore, submitted that claims 1, 6, and 11 are in condition for allowance. Furthermore, all remaining claims 3-5, 8-10 and 13-15, which depend therefrom, are also in condition for allowance.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1, 3-6, 8-11 and 12-15) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone Joseph D. Dreher, at (216) 861-5582.

Respectfully submitted,

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MINNICH & McKEE, LLP

September 27, 2006
Date

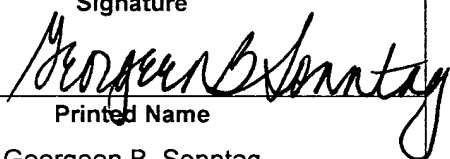


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